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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,556	09/25/2003	Yoshiichi Ozeki	243113US2	4022
22850	7590	08/24/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			FREJD, RUSSELL WARREN	
			ART UNIT	PAPER NUMBER
			2128	

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/669,556	OZEKI ET AL.	
	Examiner	Art Unit	
	Russell Frejd	2128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9.25.03</u> . | 6) <input type="checkbox"/> Other: _____ |

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Examination of Application #10/669,556

1. Claims 1-23 of application 10/669,556, filed on 25-September-2003, are presented for examination.

Claim Rejections under 35 U.S.C. § 112, 2nd Paragraph

2. Claims 1, 6, 7, 9, 14, 15, 21 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following is a list of the specific rejections:

claim 1	page 52	line 2 "... n-th part"
		line 8 "data (1)"
		line 10 "... the material property"
		line 11 "data (2)"
		line 22 "data (1) and (2)"
		the ",", should be a "," (consistently throughout the claims)
claim 6	page 54	line 23 "circumstances"
claim 7	page 55	line 1 "shape of inner surface"
		line 3 "shape of outer surface"
		line 9 "model of human"
		line 17 "model of human"
		line 19 "model of human"
claim 9	page 56	line 21 "... n-th part"
	page 57	line 1 "... the material property"

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		line 13 "data (1)"
claim 9	page 57	line 14 "(2)"
claim 14	page 59	line 23 "sensible heat"
claim 15	page 60	line 3 "shape of inner surface"
		line 5 "model of human body"
		"shape of outer surface"
		line 19 "model of human"
		line 21 "model of human"
claim 21	page 62	line 22 "... an n-th part"
		line 27 "data (1)"
	page 63	line 2 "... the material property"
		"data (2)"
		line 23 "... n-th part"
claim 23	page 63	line 26 "... n-th part"
	page 64	line 6 "... the material"

Claim Rejections under 35 U.S.C. § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

3.1 Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The invention claims (claim 1 preamble), "*A method for*

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evaluating thermal comfort of a structure constituted by a first, second, . . . n-th part (n is a natural number of at least two) wherein at least one of these parts is a translucent member for introducing light to the inside, the method for evaluating thermal comfort of a structure."

3.2 MPEP Section 2106(IV)(B)(2)(b)(ii) provides that a statutory computer process is determined not by how the computer performs the process, but by what the computer does to achieve a practical application with a useful, concrete and tangible result. For example, a computer process that simply calculates a mathematical algorithm that models noise is nonstatutory, while a claimed process for digitally filtering noise employing the mathematical algorithm is statutory. The long line of cases in this area that are referred to in MPEP Section 2106(IV)(B)(2)(b)(ii) exemplify this requirement, by utilizing in the claim language, terms such as controlling, executing, changing and removing. In view of the aforementioned requirement and the interim guidelines for 101 subject matter eligibility, the Examiner respectfully contends that the claim language of independent claims 1, 9, 21 and 23, do not claim a practical application or provide a useful, concrete and tangible result, that language claiming: (In regard to claim 1)

a step (a) of **preparing** (emphasis added) data (1) of the material property of the first part, the material property of the second part, . . . the material property of the n-th part, and data (2) of an amount of solar radiation passing through the translucent member to reach a measuring device having a shape imitating a human body part, an **amount** of solar radiation to the structure, an **amount** of convection heat transfer in the structure, an **amount** of radiation heat transfer in the structure, **humidity** in the structure and/or a thermo-regulating function of the measuring device, and **calculating** at least one of the amount of heat loss from the surface of the measuring device, the temperature of the measuring device and/or the wettedness at the surface of the measuring device based on at least one in each of data (1) and (2), and a step (b) of **calculating** a thermal comfort index of the measuring device by using a result of the above calculation.

3.3 For at least these reasons, the Examiner respectfully posits that the claims of the present invention do not meet the criteria for a statutory process. Accordingly, the claims are determined

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to be a method for evaluating thermal comfort of a structure, consisting solely of mathematical operations, converting one set of numbers into another set of numbers, whereby the method does not manipulate appropriate subject matter, and thus cannot constitute a statutory process (MPEP Section 2106(IV)(B)(2)(c)).

3.4 The Examiner also posits that the method of claims 1-23 of the present invention is computer executable software code, or a program per se, consisting of software instructions that implement the method for evaluating thermal comfort of a structure. For at least this reason, the software instructions of the present invention do not meet the criteria for a statutory process.

Allowed Claims

4. Claims 1-23 are deemed allowable over the prior art of record at this time, pending resolution of any rejections noted above.

Response Guidelines

5. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

5.1 Any response to the Examiner in regard to this non-final action should be

directed to: Russell Frejd, telephone number (571) 272-3779, Monday-Friday from 0530 to 1400 ET, **or** the examiner's supervisor, Kamini Shah, telephone number (571) 272-2279. Inquires of a general nature or relating to the status of this application should be directed to the TC2100 Group Receptionist (571) 272-2100.

mailed to: Commissioner of Patents and Trademarks
P.O. Box 1450, Alexandria, VA 22313-1450

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or faxed to: (571) 273-8300

Hand-delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

Date: 20-August-2006



**RUSSELL FREJD
PRIMARY EXAMINER**